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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,769	08/10/1999	ERWIN HACKER	514413-3765	9638
20999 7590 01/13/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
PRYOR, ALTON NATHANIEL				
ART UNIT		PAPER NUMBER		
1616				
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01/13/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/371,769

**Applicant(s)**

HACKER ET AL.

**Examiner**

ALTON N. PRYOR

**Art Unit**

1616

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/2/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-15, 21-23, 27, 28, 47-52, 57, 58 and 74 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 13-15, 21, 27, 47-50, 57 and 74 is/are rejected.

- 7) ☒ Claim(s) 22, 23, 28, 51, 52, 58 is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)  
Paper No(s)/Mail Date 11/2/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's arguments filed 11/2/09 have been fully considered but they are not persuasive. See argument below. Previous rejections/issues not discussed below have been withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 47-49 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Hudetz et al (WO 9632013; 10/17/96). Hudetz et al. teach the combination of glufosinate with metolachlor (compound A in Hudetz et al). Hudetz et al. teach a method of applying the composition to soil (area where cotton plants reside)

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15,21,50,27 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al. in view of Zhang (USPN 5885936; 3/23/99) and the 102(b) Hudetz et al.s' rejection as applied to claims 47-49 and 74 above. Hudetz et al. teach all that is recited in claims 13-15,21,50,27 and 57 except for the invention

comprising sethoxydim and bispyribac. Hudetz et al. teach herbicide combinations that can be applied to various crops including cotton crop to control weeds (page 1 paragraph 1). Hudetz et al. teach the combination of metolachlor with at least one active including glufosinate and sethoxydim (page 1 paragraph 5 – page 2 paragraph 1, page 13 paragraph 1). Although Hudetz et al. do not exemplify the combination of glufosinate plus sethoxydim, Hudetz et al. do suggest an invention including metolachlor, glufosinate plus sethoxydim. An artisan in the field would have been motivated to make such a combination since Hudetz et al. clearly teach that metolachlor addition to at least one active and further since Hudetz et al. teach that the at least one active can be glufosinate and/or sethoxydim. With respect to Hudetz et al.'s invention not comprising bispyribac, Zhang teaches a herbicide composition comprising a compound of formula I (abstract). Zhang teaches the composition can further comprise additional herbicides including glufosinate and bispyribac (column 33 line 57 – column 58 line 34). Zhang teaches a method of applying the composition to various crops including cotton for weed control (column 33 lines 25-47). Thus, it would have been obvious to modify the invention taught by Hudetz et al. to include that bispyribac taught by Zhang. An artisan in the field would have been motivated to do this since Zhang suggests the combination comprising the herbicide compound of formula I plus other herbicidal compounds such as glufosinate and bispyribac.

Claims 13,27,47,57 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruegg et al (US 6180563; 1/30/01).

Ruegg teaches a method for controlling weeds in crops including cotton comprising applying to the crop a composition comprising trifloxysulfuron plus at least one compound including glyphosate, glufosinate, sethoxydim, and clethodim. See abstract, column 1 line 5 – column 6 line 35, column 11 line 32 – column 12 line 21. Ruegg does not teach or suggest an explicit method or composition for controlling weed in cotton comprising applying to cotton a composition comprising glyphosate or glufosinate and metolachlor, pyriithobac, sethoxydim, and/or clethodim. However, it would have been obvious to one having ordinary skill in the art to make instant invention comprising trifloxysulfuron plus glyphosate or glufosinate plus metolachlor, pyriithobac, sethoxydim, and/or clethodim. One would have been motivated to do this because Ruegg suggests the combination of ingredients and the herbicidal effectiveness of the combination would have been broaden as a result of the combination. Applicant provides unexpected results for the above combination of metolachlor or pyriithobac plus glufosinate as shown on pages 31-35 of the specification. The invention comprising combinations of glufosinate plus metolachlor or pyriithobac are allowable .

*Response to Applicants' Argument*

The Ruegg reference does not recognize a benefit outside of a combination of glyphosate or glufosinate with trifloxysulfuron and the Ruegg reference would not serve as a blue print for the instant invention. Applicants argue that trifloxysulfuron is not a compound that is recited directly in the instant claims. The Examiner reiterates that the instant invention employs "comprising" language, which allows the inclusion of trifloxysulfuron. While it is true that Ruegg does not serve as a blue print for anticipating

the instant invention, Ruegg does make obvious the instant invention. Ruegg suggests in column 11 line 32 – column 12 line 21 the combination of trifloxysulfuron with at least one specified compound. Note that Ruegg specifically names the at least one compound which includes the instant compounds glufosinate, sethoxydim and clethodim. This teaching by Ruegg allows for trifloxysulfuron to be combined with compounds glufosinate, sethoxydim and/or clethodim. The combinations of ingredients are not resulting from a mere picking and choosing since the Ruegg specifically names the compounds, which can be combined trifloxysulfuron. In addition it is obvious to combine substances of the same utility with the expectation of obtaining at least an additive effect. Note that a prior art reference does not have to recite all the possible combinations of ingredients in order to make an invention obvious.

Ruegg names glufosinate, metolachlor, pyriithobac, sethoxydim and clethodim, but only in the context of combination with a trifloxysulfuron. This is no indication that combination of these named herbicides with one another in the absence of trifluoxysulfuron would provide unexpected results against harmful plants. The Examiner reiterates that all named herbicides are well known; therefore, it would have been obvious to combine the named herbicides with the expectation of creating final combinations that would be herbicidal.

Applicants provide unexpected results for the combination of clethodim or metalachlor or pyriithobac with glufosinate(ammonium).

Applicants provide no unexpected results for the combination of known herbicide, bispyribac or sethoxydim with glufosinate(ammonium), which is also a known herbicide.

***Claim Objection***

Claims 22,23,28,51,52 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim. The specification at pages 31-35 provides unexpected results for an invention comprising glufosinate plus clethodim, metolachlor, or pyriithiobac.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Alton N. Pryor/  
Primary Examiner, Art Unit 1616